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REMARKS

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The elected claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited, and such action is respectfully requested.

Rejections**Rejection Under 35USC §112 First Paragraph**

Claim 133 has been rejected under 35 USC §112, paragraph 1, as failing to comply with the written description requirement.

The Office states that "the limitation 'automatically cause the digital print mechanism to generate at least one final print in response to the enhancement of the digitally stored image' is not present in the disclosure nor is similar language describing the act" (Office Action, p.2). Applicants respectfully disagree.

The specification discloses that:

"The combination proof sheet and order form includes a graphical representation of at least one of the images and a plurality of user designation areas. The printer has circuitry and software for detecting the user designation areas on the form that have been completed by the user. The programming in the printer thereafter causes it to generate at least one final print sheet with the images and enhancements designated by the user on the combination proof sheet and order form." (specification, p.4, ln. 6)

Thus, after the user submits the user-completed proof sheet and order form to the printer, the printer automatically detects the completed user designation areas on the form, performs the requested enhancements designated by the user on the form, and generates at least one final print

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sheet with the user-designated images and enhancements.

In light of this explanation, it is submitted that the specification explicitly or inherently discloses the limitation of claim 133, and that the rejection under 35 USC §112, paragraph 1, is improper and should be withdrawn.

Rejection Under 35 USC §103

Claims 21, 26-28, 30-32, 34-37, 41, 43-52, 54-57, 61-62, 64-65, 68, 70, 72-73, 113-114, 123-126, 129-131, and 134 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"). Applicants respectfully traverse the rejection and request reconsideration.

As to a rejection under §103(a), the U.S. Patent and Trademark Office ("USPTO") has the burden under §103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

More recently, the Supreme Court, quoting In Re Kahn, 441 F.3d, 977, 988 (CA Fed. 2006), has clarified that "[R]jections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to

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support the legal conclusion of obviousness” Teleflex Inc. v. KSR Int’l Co., 82 USPQ2d 1385, 1396 (S.Ct. 2007).

The rejection of independent claim 43, and its dependent claim 44, is respectfully traversed for at least the following reasons. Claim 43 recites:

“43. (Previously presented) A printer for enabling a user to select and print a plurality of digitally stored images accessible by the printer, the printer comprising:

a digital print mechanism capable of generating graphical representations of selected ones of the plurality of digitally stored images and a plurality of user designation areas on a print medium;

a scanner mechanism capable of detecting at least one user designation area on the print medium after it has been completed by a user;

program logic configured to cause the digital print mechanism to generate a combination proof sheet and order form that incorporates at least one of the plurality of images and the plurality of user designation areas;

program logic configured to cause the scanner mechanism to scan the combination proof sheet and order form after at least one of the plurality of user designation areas has been completed by a user and the combination proof sheet and order form has been inserted into the scanner mechanism;

program logic configured to interpret one or more of the user designation areas completed by the user and detected by the scanner mechanism; and

program logic configured to cause the digital print mechanism to automatically generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in response to the detection and interpretation of, and in accordance with, the user designation areas completed by the user.” (emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicants’ claim limitations.

First, claim 43 recites that the printer includes a digital print mechanism that generates on a print medium a combination proof sheet and order form that includes a graphical representation of at least one digitally stored image and a plurality of user designation areas. With regard to this limitation, the Office points to the printer mechanism of col. 3, ln. 37-45 of the Hicks reference (Office Action, p.6). However, this printer mechanism is “a mechanical or character printer mechanism” which imprints “the group code, frame number and composition data on the proof

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paper” (col. 3, ln. 37-45). This printer mechanism does not form a graphical representation of an image on the form; a mechanical or character printer is incapable of forming such graphical representations. Instead, “the negatives are printed in proof form on a single sheet of proof paper or ‘contact sheet’” that becomes the order form when later imprinted by the mechanical or character printer (col. 3, lines 21-23; emphasis added). Thus, in the Hicks reference, at least two different mechanisms, at least one of which is not digital, are required to produce the combination proof sheet and order form. The additional optical photographic print production equipment and associated chemical processing adapted for making prints from film is neither digital nor part of the mechanical or character printer.

The Office does not take the position that the Yamaguchi reference teaches or suggests such a limitation. The Office contends only that “Yamaguchi ‘178 discloses printing digital images and a printer with a scanner mechanism capable of scanning and printing photos” (Office Action, p.7). Applicants believe the Yamaguchi reference does not teach or suggest a digital print mechanism that generates a combination proof sheet and order form that incorporates at least one of the plurality of images and the plurality of user designation areas. More particularly, the Yamaguchi reference does not teach or suggest the printing of any combination proof sheet and order form at all. The printer of the Yamaguchi reference only produces final photographic prints corresponding to single, individual negatives. Furthermore, no combination proof and order sheet is used in the Yamaguchi reference to instruct the print mechanism for which images the user desires to produce final print sheets. Instead, whatever printing instructions are needed are supplied by an operator viewing the image on a monitor via a keyboard (col. 11, ln. 1-8).

Second, claim 43 recites that the same print mechanism generates both the combination proof sheet and order form, and the final print sheets. There is no disclosure in the Hicks reference that a single print mechanism produces both these items. The photographic lab of the Hicks reference utilizes a large number of different pieces of equipment - silver halide film developing equipment, computers, scanners, mechanical printing equipment, as well as chemical and optical photographic print production equipment. Details of the precise nature of this

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equipment, and its interconnections, are not specified in Hicks. However, the system disclosed in the Hicks reference is directed towards a photographic lab business for producing photographic packages for institutional groups such as school children, church congregations, clubs and other organizations (col. 1, lines 10-13). Given the large print volume produced in such a lab, it is likely that the lab would have multiple units of any particular type of equipment, even assuming, arguendo, that the same piece of equipment could produce both the proof and order sheet and the final prints. The setup time needed to convert a particular piece of photographic print production equipment from proof printing to final print generation makes it unreasonable to conclude that a single print mechanism would inherently be used to produce both the combination proof and order sheet and the final prints, switching back and forth from one operation to another each time. Nor does the Yamaguchi reference teach or suggest that the same print mechanism generates both the combination proof sheet and order form, and the final print sheets because there is no disclosure in the Yamaguchi reference of any combination proof sheet and order form.

Third, claim 43 recites that the digital print mechanism automatically generates the final print sheets in response to the detection and interpretation of, and in accordance with, the user designation areas completed by the user. In the Hicks reference, the final print sheets are not automatically generated (col. 4, lines 16-30). The Office states that the Hicks reference teaches that "col. 4, lines 16-30, order forms may be automatically entered by entering through a read device" (Office Action, p.6). The Hicks reference discloses:

"Upon receipt of the envelope containing the print and order form and payment (and as seen in block 9 of FIG. 1) an operator at the photographic lab enters order data into the computer data base 12 corresponding to the packages selected of each proof print by the subject. Alternatively, the marks made on the order form 26 by the subject may be machine readable in which case the order data from the order forms may be automatically entered into the computer data base by passing the combined print and order form through a suitable read device.

Thereafter, as seen in block 10, the identifying data, the order data, and the composition data are supplied from the computer data base and are utilized to produce the final photographic prints." (col. 4, lines 16-30; emphasis added)

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It is noted that the only automatic operation that the Hicks reference discloses is the automatic entry into the computer data base of the customer's order data from the order form. There is no disclosure that any final prints are produced in response to the detection and interpretation of the data on the order form. All that automatically occurs in response to the detection and interpretation of the data on the order form is that the order data is entered into the computer data base. Instead, the Hicks reference discloses that at some unspecified time thereafter – i.e., after the order data has been entered into the data base - the order data is supplied from the computer data base, and then used to produce the final prints.

Furthermore, it is not possible for the system described in the Hicks reference to automatically produce final prints in response to the detection and interpretation of the order data on the order form. The images of the Hicks reference are not digitally stored images, but rather are film images:

“the exposed film is sent to the photographic lab and developed in known manner as represented by block 2. ... for each subject, the developed film, as seen in block 3, is marked with an identifying group code or name and a frame member, whereafter the film is adjusted for composition, whereafter the identifying data and the composition data are stored in a computer data base represented by block 12. Thereafter, as seen in block 4, the negatives are printed in proof form on a single sheet of proof paper or "contact sheet" using stored composition data from the computer data base, and an order form is printed on the same sheet of proof paper simultaneously with the printing of the proof prints. The order form is printed on the proof paper using either a computer generated image or a previously prepared photographic negative image.” (col. 3, lines 10-28; emphasis added)

There is no teaching or suggestion in the Hicks reference that the film images are ever digitized or stored, even though composition data is stored in a computer data base. There is no digitizer disclosed or suggested in the Hicks reference that could convert the film negatives into a digital image file. Thus, when the operator of the system wishes to produce final prints in accordance with a customer's order data in the data base, the negatives or other film images corresponding to the order data must first be physically retrieved according to the group code and frame number stored in the data base (col. 3, ln. 37-45) and corresponding to the order data. As a result, it is not possible for the final prints to be automatically produced in response to the

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detection and interpretation of the order data on the order form. Nor does the Yamaguchi reference teach or suggest this limitation, because there is no disclosure in the Yamaguchi reference of any combination proof sheet and order form at all. Furthermore, to produce prints having adjusted gray balance as taught by the Yamaguchi reference, the final prints are not automatically generated:

"The operator (or the person who received a printing order) views the visible image displayed on the CRT monitor 71 and inputs information, which represents corrected values for the image processing, from the keyboard 73, when necessary, such that a visible reproduced image having more appropriate image density, gradation, colors, and sharpness may be obtained." (col. 11, ln. 2-8; emphasis added)

Fourth, claim 43 recites that the digital print mechanism automatically generates the final print sheets in response to the detection and interpretation of, and in accordance with, the user designation areas completed by the user. The Hicks reference, as discussed heretofore, utilizes optical photographic print production equipment and associated chemical processing adapted for making prints from film, not a digital print mechanism, to generate the final print sheets. In the Yamaguchi reference, the final prints are not in accordance with any user designation areas completed by the user on a combination proof and order sheet, because no such combination proof and order sheet is disclosed in the Yamaguchi reference.

Therefore, for the reasons discussed herein, the applied references, alone or in combination, do not teach or suggest all of Applicants' claim limitations, and thus the rejection is improper at least for this reason and should be withdrawn.

Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no articulated reason with some rational underpinning that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. The Office states that

"it would have been obvious to a person of ordinary skill in the art to utilize a printer capable of scanning and printing digital photos. The motivation for doing so would have been to combine the functions of a scanner and photo printer with those of a document printer and to

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increase image quality" (Office Action, p.7).

With regard to combining the functions of a scanner and photo printer with those of a document printer, neither the Hicks reference nor the Yamaguchi reference teaches a combined scanner, photo printer, and document printer. Assuming, arguendo, and which Applicants do not concede, that the mechanical or character printer of the Hicks reference constitutes a "document" printer, the Hicks reference discloses only a separate document printer, and a separate optical/chemical photo printer. The Hicks reference does not disclose a scanner. The Yamaguchi reference discloses a scanner and an optical/chemical photo printer which, again arguendo, is assumed to be a single unit. However, the Yamaguchi reference does not disclose a document printer. The only teaching or suggestion to combine the functions of a scanner and photo printer with those of a document printer into a single printer, as recited in claim 43, comes from Applicants' specification, which constitutes impermissible hindsight. While such multifunction printers may be in common use today, such was not the case at the 1998 priority date of Applicants' invention. Furthermore, with regard to increasing image quality, it is uncertain how or whether, given the state of the art in 1998, a second-generation photographic print (film image, to digital image, to light projected onto photographic paper) produced according to the Yamaguchi reference could have higher image quality than a first-generation photographic print (film image directly projected onto photographic paper) produced according to the Hicks reference. It is well known that later-generation analog prints have inferior quality to prior-generation analog prints. Regardless of the image processing performed on the digital image of the Yamaguchi reference, it is not evident that the resulting image has uniformly increased image quality; for example, improvements in gray balance could be offset by digitization artifacts. Furthermore, there is no disclosure or suggestion in the Hicks reference of a need for improvement in gray balance. It is well known that photographic laboratories, of the type disclosed in Hicks, employ alternate methods for color balance, such as color filters, during the printing process. So it is unlikely that combining the teachings of the Yamaguchi reference with the teachings of the Hicks reference will result in an increase in image quality for prints

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produced by the photographic laboratories of the Hicks reference.

Therefore, the reasoning articulated by the Office lacks sufficient rational underpinning to support the legal conclusion of obviousness. The Office impermissibly uses Applicants' disclosure as a blueprint or in hindsight for the rejection. Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Accordingly, it is improper to combine the Hicks and Yamaguchi references, and the rejection under 103(a) should be withdrawn at least for this reason.

Independent claims 47 and 72 each recite limitations similar to those of claim 43, discussed above.

Claim 47 recites:

"47. (Previously presented) A method for selecting and printing digitally stored images available to a digital printer, comprising:

generating with the digital printer a combination proof sheet and order form having a graphical representation of at least one of the images and a plurality of user designation areas;

scanning with the digital printer the combination proof sheet and order form after a user has completed at least one of the user designation areas thereon;

detecting and interpreting the completed user designation areas with the digital printer;

and
automatically printing with the digital printer, responsive to the detecting and interpreting, at least one final print of at least one of the digitally stored images in accordance with the completed user designation areas." (emphasis added)

Claim 72 recites:

"72. (Previously presented) A method for selecting and printing digitally stored images, comprising:

receiving in a digital printer a plurality of the digitally stored images;

generating with the digital printer a combination proof sheet and order form that incorporates a graphical representation of at least one of the images and a plurality of user designation areas;

receiving with the digital printer the combination proof sheet and order form after a user has completed at least one of the user designation areas thereon and the form has been re-inserted into the digital printer;

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utilizing the digital printer to detect and interpret the completed user designation areas on the re-inserted combination proof sheet and order form; and

automatically generating with the digital printer, responsive to the detection and interpretation of the completed user designation areas, at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the completed user designation areas." (emphasis added)

For similar reasons as explained heretofore with regard to claim 43, the features of the present invention are not taught or suggested by the cited references in combination in that the features of a digital printer generating a combination proof sheet and order form that has a graphical representation of at least one digitally stored images and a plurality of user designation areas, the features of the same digital printer generating both the combination proof and order sheet and the final print sheets of the digitally stored images, the features of automatically generating the final print sheets in response to the detecting and interpreting of user-completed areas on the combination proof and order sheet, and the features of generating the final print sheets on the digital printer in accordance with the completed user designation areas, are neither taught nor suggested by the Hicks and Yamaguchi references in combination.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection of independent claims 47 and 72, and dependent claims 48-52, 54-57, 61-62, 64-65, 68, and 70, is improper at least for that reason and should be withdrawn.

Independent claims 21, 45, 46, 123, and 129 each recite at least some limitations discussed above with regard to claim 43 and which patentably distinguish these claims from the cited references.

Claim 21 recites:

"21. (Previously presented) A printer for enabling a user to select and print a plurality of digitally stored images accessible by the printer, comprising:

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a digital print mechanism configurable by program logic to generate a combination proof sheet and order form having graphical representations of selected ones of the plurality of digitally stored images and a plurality of user designation areas;

a scanner mechanism configurable by program logic to detect and interpret at least one user-completed one of the user designation areas after the form has been inserted into the scanner mechanism; and

program logic configured to cause the digital print mechanism to generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the at least one detected and interpreted user-completed one of the user designation areas." (emphasis added)

Claim 45 recites:

"45. (Previously presented) A system for enabling a user to select and print a plurality of digitally stored images, the system comprising:

a digital printer capable of generating graphical representations of selected ones of the plurality of images and a plurality of user designation areas on a print medium;

a scanner capable of detecting at least one user designation area on the print medium after it has been completed by a user;

program logic configured to cause the digital printer to generate a combination proof sheet and order form that incorporates at least one of the plurality of images and the plurality of user designation areas;

program logic configured to cause the scanner to scan the combination proof sheet and order form after at least one of the plurality of user designation areas has been completed by a user and the combination proof sheet and order form has been inserted into the scanner;

program logic configured to interpret one or more of the user designation areas completed by the user and detected by the scanner; and

program logic configured to cause the digital printer to generate at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the user designation areas completed by the user." (emphasis added)

Claim 46 recites:

"46. (Previously presented) A system for enabling a user to select and print a plurality of digitally stored images, comprising:

a digital printer configurable by stored program logic to generate a combination proof sheet and order form having graphical representations of selected ones of the plurality of images and a plurality of user designation areas;

a scanner coupled to the printer and configurable by stored program logic to detect and interpret at least one user-completed one of the user designation areas after the form has been inserted into the scanner; and

program logic configured to cause the digital printer to generate at least one final print

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sheet having a graphical representation of at least one of the digitally stored images in accordance with the at least one detected and interpreted user-completed one of the user designation areas.” (emphasis added)

Claim 123 recites:

“123. (Previously presented) A computer-readable medium storing a program for printing selected ones of a plurality of digitally stored images, comprising:

code that controls a digital print mechanism to generate a combination proof sheet and order form having graphical representations of the plurality of digitally stored images and a plurality of user designation areas;

code that controls a scanner mechanism to scan the combination proof sheet and order form after completion by a user;

code that detects on the scanned proof sheet and order form at least one user-completed one of the user designation areas;

code that interprets the at least one user-completed one of the user designation areas to identify at least one user-selected one of the images; and

code that controls the digital print mechanism to generate at least one final print of the at least one user-selected one of the images.” (emphasis added)

Claim 129 recites:

“129. (Previously presented) A printer for enabling a user to select and print a plurality of digitally stored images accessible by the printer, comprising:

means for generating with a digital print mechanism a combination proof sheet and order form having graphical representations of selected ones of the plurality of digitally stored images and a plurality of user designation areas;

means for detecting and interpreting at least one user-completed one of the user designation areas; and

means for generating with the digital print mechanism at least one final print sheet having a graphical representation of at least one of the digitally stored images in accordance with the at least one detected and interpreted user-completed one of the user designation areas.” (emphasis added)

For similar reasons as explained heretofore with regard to claim 43, the features of the present invention are not taught or suggested by the cited references in combination in that the features of a digital printer or print mechanism generating a combination proof sheet and order form that has a graphical representation of digitally stored images and a plurality of user designation areas, the features of the same digital printer generating both the combination proof and order sheet and the final print sheets of the digitally stored images, and the features of

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generating the final print sheets on the digital printer in accordance with the completed user designation areas, are neither taught nor suggested by the Hicks and Yamaguchi references in combination.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection of independent claims 21, 45, 46, 123, and 129, and their corresponding dependent claims 26-28, 30-32, 34-37, 41, 124, 130-131, and 134 is improper at least for that reason and should be withdrawn.

Independent claims 113 and 125 (both currently amended) each recite at least some limitations discussed above with regard to claim 43 and which patentably distinguish these claims from the cited references.

Claim 113 recites:

"113. (Previously presented) At least one processor-readable medium having processor-executable instructions therein which, when executed by a processor, cause the processor to perform operations comprising:

controlling a digital print mechanism to generate a combination proof sheet and order form having graphical representations of a plurality of digitally stored images accessible by the processor and a plurality of user designation areas;

controlling a scanner mechanism to scan the combination proof sheet and order form after completion by a user;

detecting on the scanned proof sheet and order form at least one user-completed one of the user designation areas; and

interpreting the at least one user-completed one of the user designation areas to identify at least one user-selected one of the images and at least one user-selected print characteristic associated with the at least one user-selected one of the images." (emphasis added)

Claim 125 recites:

"125. (Previously presented) A printer, comprising:

means for generating with a digital print mechanism a combination proof sheet and order form having graphical representations of a plurality of digitally stored images and a plurality of user designation areas;

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means for detecting on the combination proof sheet and order form at least one of the user designation areas completed by a user;

means for interpreting the at least one user-completed one of the user designation areas so as to identify at least one user-selected one of the images and at least one user-selected print characteristic associated with the at least one user-selected one of the images.” (emphasis added)

For similar reasons as explained heretofore with regard to claim 43, the features of the present invention are not taught or suggested by the cited references in combination in that the features of a digital print mechanism generating a combination proof sheet and order form that has graphical representations of digitally stored images and a plurality of user designation areas are neither taught nor suggested by the Hicks and Yamaguchi references in combination.

Applicants respectfully traverse the Office’s assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants’ invention. Such could be possible only in hindsight and in light of Applicants’ teachings. Therefore, the rejection of independent claims 113 and 125, and their corresponding dependent claims 114 and 126, is improper at least for that reason and should be withdrawn.

Independent claim 73 recites at least some limitations discussed above with regard to claim 43 and which patentably distinguish this claim from the cited references.

Claim 73 recites:

“73. (Previously presented) A method for selecting and printing digitally stored images, comprising:

generating a combination proof sheet and order form having a graphical representation of at least one of the images and a plurality of user designation areas;

scanning the combination proof sheet and order form after a user has completed at least one of the user designation areas thereon;

detecting and interpreting the completed user designation areas; and

automatically printing, responsive to the detecting and interpreting, at least one final print of at least one of the digitally stored images in accordance with the completed user designation areas.” (emphasis added)

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For similar reasons as explained heretofore with regard to claim 43, the features of the present invention are not taught or suggested by the cited references in combination in that the features of automatically generating at least final print in response to the detecting and interpreting of completed user designation areas on the combination proof and order sheet are neither taught nor suggested by the Hicks and Yamaguchi references in combination.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection of independent claim 73 is improper at least for that reason and should be withdrawn.

The rejections of dependent claims 130-131 and 134 are further traversed for at least the following additional reason. All of these claims recite the limitation that the final print sheets are automatically generated in response to the detecting and interpreting of user-completed ones of the user designation areas. For similar reasons as explained heretofore with regard to claim 43, neither the Hicks nor Yamaguchi references, in combination, disclose such a limitation. Therefore, the rejection of these dependent claims is improper and should be withdrawn at least for this additional reason.

Claim 22 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi") and further in view of U.S. patent 5,511,771 to Rubscha ("Rubscha"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on independent claim 21, whose reasons for allowability over the Hicks and Yamaguchi references have been discussed heretofore and against which the Rubscha reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly

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uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claims 23 and 39 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi") and further in view of U.S. patent 5,511,771 to Hirayama ("Hirayama"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on independent claim 21, whose reasons for allowability over the Hicks and Yamaguchi references have been discussed heretofore and against which the Hirayama reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claim 24 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi") and further in view of U.S. patent 5,583,629 to Brewington ("Brewington"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on independent claim 21, whose reasons for allowability over the Hicks and Yamaguchi references have been discussed heretofore and against which the Brewington reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claim 25 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi

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("Yamaguchi") and further in view of U.S. patent 5,398,131 to Hall ("Hall"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on independent claim 21, whose reasons for allowability over the Hicks and Yamaguchi references have been discussed heretofore and against which the Hall reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claim 29 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi") and further in view of U.S. patent 5,124,742 to Yoshikawa ("Yoshikawa"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on independent claim 21, whose reasons for allowability over the Hicks and Yamaguchi references have been discussed heretofore and against which the Yoshikawa reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claim 33 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi") and further in view of U.S. patent 3,959,784 to Meier ("Meier"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on independent claim 21, whose reasons for allowability over the Hicks and Yamaguchi references have been discussed heretofore and against which the Meier reference has not been cited. In addition, the stated motivation to combine the references is improper in that it

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is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claims 40, 59-60, 74-76, 79-82, 84-86, 89, 91, 93, 95, 117, 127, 132, and 133 have been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. patent 4,441,807 to Bartz ("Bartz"). Applicants respectfully traverse the rejection and request reconsideration.

The rejection of independent claim 74, and its dependent claims 75-76, 79-82, and 84, is respectfully traversed for at least the following reasons. Claim 74 recites:

"74. (Previously presented) A method for enhancing a digitally stored image available to a digital printer, comprising:

generating with the digital printer a form having at least one graphical representation of the digitally stored image, and a plurality of user designation areas each associated with at least one of the graphical representations and indicative of a particular image enhancement applicable to the image;

scanning the form with the digital printer after a user has completed at least one of the user designation areas;

detecting and interpreting the completed user designation areas with the digital printer; and

automatically enhancing, responsive to the detecting and interpreting, the digitally stored image with the digital printer in accordance with the completed user designation areas."

(emphasis added)

The Office has not established a *prima facie* case of obviousness at least because the applied references do not teach or suggest all of Applicant's claim limitations.

For similar reasons as explained heretofore with regard to claim 43, the Hicks and Yamaguchi references in combination do not teach or suggest the features of generating with a digital printer a form having both at least one graphical representation of a digitally stored image and a plurality of user designation areas each associated with at least one of the graphical

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representations. The Office does not cite the Bartz reference as teaching such features, and it is believed that the Bartz reference does not teach or suggest such features.

With regard to the feature of automatically enhancing the digitally stored image with the digital printer responsive to detecting and interpreting the completed user designation areas, the Office states that the Hicks reference does not disclose "a user designation area associated with image enhancement" (Office Action, p.20). The Office does not assert that the Yamiguchi reference teaches this limitation, and Applicants believe that the the Yamiguchi reference does not teach this limitation. However, the Office states that the Bartz reference discloses this limitation via a user designation area at mark box column 18 and 19 of table 17 of Fig. 1, and an operation of generating commands to the printer to automatically control the exposure at col. 1, ln. 59 – col. 2, ln. 14 (Office Action, p.20).

Applicants respectfully disagree. The generation of commands to the printer to automatically control the exposure is not performed responsive to detecting and interpreting the completed user designation areas (i.e. mark box column 18 and 19 of table 17). The Bartz reference discloses:

"The lefthand column of table 16 represents, at some mark box locations, the quantity of prints of a particular size, the size being indicated in the righthand column. By tracing, with a suitable pencil or pen, in known manner, those portions of the character outline in the lefthand column mark boxes that represent the desired number of prints of a size represented by the mark box location, a manual, optically readable character (numeral) is produced at the mark box location. These trace characters may then be optically read with the detected number, and the location of the mark box serving to indicate the desired number of each print size. ...

In a preferred embodiment, the magnetic strip 20 is a dual track strip ... The other track of tape 20 includes a plurality of data blocks dedicated to printer exposure parameters including those printer exposure parameters represented by the mark box locations of tables 16 and 17. Thus, with data entered in the mark box locations of the tables 16 and 17, as by tracing the relevant portions of the ghost character outlines, those locations may be read by an optical character reader with that information then being recorded in the associated printer exposure parameter data block dedicated to the particular parameter. Thus, the card may carry the entirety of the necessary exposure parameters such that card sequence is non-critical during the printing operation. That is, the cards, each bearing the necessary exposure information independently of the other cards or an independently recorded record, may be processed in any desired sequence."

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(col. 3, ln. 64 – col. 4, ln. 16; emphasis added)

Thus, as disclosed by the Bartz reference, the marks made by a user in mark box columns 18 and 19 are read by an optical character reader, and data corresponding to the user marks stored in data blocks on the magnetic strip 20 of the masking card carrying the corresponding negative. This operation must be performed prior to enhancing the image. The data is stored in the data blocks of the magnetic strip 20 responsive to the detecting and interpreting of the marks in the mark boxes by the optical character reader. The Office apparently equates exposing the negative on the masking card to enhancing a digitally stored image, a characterization with which Applicants disagree. However, even if, *arguendo*, the Office's position in this regard is correct, the film or negative on the masking card is not exposed responsive to the detecting and interpreting of the marks in the mark boxes. Instead, the masking card on which the exposure parameters are stored in the magnetic strip 20 after the optical scanning of the marks has been completed, may (or may not) be eventually input to the photo printer in a subsequent operation for printing an image of the film or negative carried by the masking card. The Bartz reference clearly teaches that this is done in a subsequent operation when it discloses that the masking cards can be supplied to the photo printer in any order or sequence. Thus any automatic enhancing of an image is not performed responsive to the detecting and interpreting of completed user designation areas (i.e. the marks in the mark boxes).

Furthermore, the optical character reader which detects and interprets the completed user designation areas is not part of the printer, as is further required by the claim. If the optical character reader were part of the printer, there would be no need to include the magnetic strip 20 on the masking card, because the printer could just obtain the exposure parameters in an optical fashion directly from the mark box columns. However, this is contrary to the disclosed operation and capabilities of the Bartz reference.

Therefore, for the reasons discussed herein, the applied references, in combination, do not teach or suggest all of Applicants' claim limitations, and thus the rejection is improper at least for this reason and should be withdrawn.

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Furthermore, the Office has not established a *prima facie* case of obviousness at least because there is no articulated reason with some rational underpinning that would have prompted a person of ordinary skill in the relevant field to combine the prior art elements in the manner claimed. *In Re Kahn*, 441 F.3d, 977, 988 (CA Fed. 2006). A patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art. The Office states that the Bartz reference can be combined with Hicks reference because the "motivation for doing so would have been to allow the user to crop and choose the color of ordered prints" (Office Action, p.18). Applicant believes that this reason is merely a recitation of features disclosed in Applicants' invention. As such, the rejection relies on impermissible hindsight.

In addition, the combination of the Hicks and Bartz references would produce an inoperative device that destroys the intended results of the references. "If references taken in combination would produce a 'seemingly inoperative device', we have held that such references teach away from the combination and thus cannot serve as predicates for a prima facie case of obviousness" *McGinley v. Franklin Sports Inc.*, 60 USPQ2d 1001, 101 (Fed. Cir. 2001); emphasis added.

First, using the masking card of the Bartz reference in the system of the Hicks reference would result in the Hicks reference being inoperative to produce final prints from order information. In the Hicks reference:

"The combined print and order form 14 is now delivered to the subject with an envelope 32 sized to receive the combined print and order form and including detailed information with respect to the packages symbolically identified on the combined print and order form by the package number blocks 1-7. ... Using the combined print and order form 14 and the information provided on the flap 32a of envelope 32, the subject marks the order form on the combined print and order form to indicate the packages desired for each proof print. ... Following the selection of the desired final photographic prints, by appropriate use of the order forms printed beneath each proof print, the subject deposits the marked print and order form in the envelope 32, places a payment in the envelope corresponding to the combined price of the packages selected, and returns the marked print and order form, with the payment, in the envelope to the photographic lab" (col. 3, ln. 46 – col. 4, ln. 15; emphasis added).

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This the user takes the combination proof sheet and order form away from the photographic lab, cogitates on it to determine which, if any, prints to order, and returns the marked order form to the photographic lab, possibly in person but more likely by mail. If the masking card of the Bartz reference were part of the combination proof sheet and order form, the original film (transparency or negative) of the image would be provided to the user. Delivering the original film to the potential purchaser runs the risk that the original photographic image could be lost in transit, or never returned to the lab by the user. It also runs the risk that the user might decide instead to take the film negative to his own local film processor for making final prints at a lower cost, since the package price includes additional costs such as the cost of the original photography session at which the photos were taken, as well as a markup. If the film was not mounted to the masking card in order to eliminate these risks, the combined invention would be inoperative because the user would not know which photograph corresponds to which masking card.

The combination would be further inoperative because the user (i.e. the subject of the photographs who receives the combination proof and order form) would not have the necessary technical knowledge to properly fill out the exposure parameter mark boxes on the masking card of the Bartz reference. These parameter mark boxes include, for example, an exposure setting and a color balance setting to be used with the corresponding negative. Exposure and color balance settings relate to the enlarging and photographic printing equipment of the lab which are determined by a photographic lab technician operating the equipment, and are not known to the purchaser. For example, color balance settings involve selecting numeric filter density values for the various color filters used to produce a print of the proper color, and in the case of color negatives, must include neutralizing the orange cast of the film itself.

Second, using the combination proof and order form of the Hicks reference in the system of the Bartz reference would result in the Bartz reference being inoperative to produce final prints from the image information on the form. The masking card of the Bartz reference carries the film itself. However, the combination proof and order form of the Hicks reference, which has

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been returned from a customer, does not; it only includes a contact print (graphical representation) of the negative. It is clear that a final photographic print cannot be produced by the system of the Bartz reference by inserting the combination proof and order form of the Hlicks reference into the printer, even if the form were somehow modified to include the magnetic strip of the Bartz reference, because the form does not contain the film or negative itself.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection is improper at least for this reason and should be withdrawn.

Independent claim 85 recites at least some limitations similar to those of claim 74, discussed above.

Claim 85 recites:

"85. (Previously presented) A printer for enabling a user to enhance a digitally stored image accessible by the printer, comprising:

a digital print mechanism configurable by program logic to generate a form having at least one graphical representation of the digitally stored image, and a plurality of user designation areas each associated with at least one of the graphical representations and indicative of a particular image enhancement applicable to the image;

a scanner mechanism configurable by program logic to detect and interpret at least one user-completed one of the user designation areas after the form has been inserted into the scanner mechanism; and

program logic configured to cause a processor in the printer to enhance the digitally stored image in accordance with the completed user designation areas." (emphasis added)

For similar reasons as explained heretofore with regard to claim 74, the features of the present invention are not taught or suggested by the cited references in that the features of a digital print mechanism for generating a form having at least one graphical representation of the digitally stored image, and a plurality of user designation areas each associated with at least one

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of the graphical representations are neither taught nor suggested by the Hicks reference in combination with the Bartz reference and well known prior art.

Applicants respectfully traverse the Office's assertion that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include the features recited in the claims of Applicants' invention. Such could be possible only in hindsight and in light of Applicants' teachings. Therefore, the rejection of independent claim 85, and its dependent claims 86, 89, 91, 93, 95, and 132-133, is improper at least for that reason and should be withdrawn.

The rejection of dependent claim 132 is further traversed for at least the following addition reason. Claim 132 recites the limitation that the image is enhanced in response to the detection and interpretation of at least one user-completed one of the user designation areas. For similar reasons as explained heretofore with regard to claim 43, neither the Hicks nor Yamaguchi references, in combination, disclose such a limitation. Nor does the Bartz reference disclose such a limitation, alone or in combination with the Hicks and Yamaguchi references. Therefore, the rejection of this dependent claim is improper and should be withdrawn at least for this additional reason.

The rejection of dependent claims 40, 59-60, 117, and 127 is respectfully traversed at least based on the dependence of these claims on one of independent claims 21, 47, 113, and 125, whose reasons for allowability over the Hicks and Yamaguchi references have been discussed heretofore and against which the Bartz reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

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In addition, dependent claim 40 is further patentably distinguishable because the applied references do not teach or suggest all the claim limitations thereof. Claim 40 recites:

"40. (Currently amended) The printer of claim 21 wherein the digital print mechanism is further configurable by stored program logic to generate a custom proof sheet and order form having at least one graphically represented image and user designation cropping areas along adjacent side edges of the image, the user designation cropping areas markable by the user to graphically indicate two-dimensional cropping positions for the image." (emphasis added)

The Office admits that the Hicks reference does not disclose user designation cropping areas but takes the position that the Bartz reference discloses such areas in the form of "mark box columns 18 and 19 of Fig. 1, col. 3, lines 12-15" (Office Action, p.18). However, to whatever extent, if any, that such mark boxes are user designation cropping areas, they are not disposed along adjacent side edges (plural) of the image; rather, they are all disposed along a single side edge of aperture 14 (Bartz, Fig. 1). Furthermore, the mark box columns 18,19 do not graphically indicate two-dimensional cropping positions for the image, as do user designation cropping areas disposed along adjacent side edges of Applicants' specification (Fig. 4, series of equally spaces bubbles 67,68; Specification, p.12, lines 4-10).

Therefore, for the reasons discussed herein, the applied references do not teach or suggest all of Applicants' claim limitations, and thus the rejection of claim 40 is improper at least for this additional reason and should be withdrawn.

Claim 58 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. patent 5,178,417 to Eshoo ("Eshoo"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on independent claim 47, whose reasons for allowability over the Hicks and Yamaguchi references have been discussed heretofore and against which the Eshoo reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the

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Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claim 53 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. patent 5,907,391 to Kobayashi ("Kobayashi"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on independent claim 47, whose reasons for allowability over the Hicks and Yamaguchi references have been discussed heretofore and against which the Kobayashi reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claim 63 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), and further in view of U.S. patent 5,426,481 to Slater ("Slater"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on independent claim 47, whose reasons for allowability over the Hicks and Yamaguchi references have been discussed heretofore and against which the Slater reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claim 69 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi

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("Yamaguchi"), and further in view of well known prior art. Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on independent claim 47, whose reasons for allowability over the Hicks and Yamaguchi references have been discussed heretofore. In addition, the stated motivation to combine or modify the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claim 77 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), further in view of U.S. patent 4,441,807 to Bartz ("Bartz"), and further in view of U.S. patent 6,181,409 to Calhoun ("Calhoun").

Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on claim 74, whose reasons for allowability over the Hicks, Yamaguchi, and Bartz references have been discussed heretofore and against which the Calhoun reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claim 77 is further respectfully traversed for at least the following additional reasons. Claim 74 recites:

"77. (Previously presented) The method of claim 74, wherein the form has a plurality of graphical representations of the digitally stored image and at least one user designation area associated with each graphical representation, each graphical representation prospectively indicative of the effect of the enhancement." (emphasis added)

The Office states that the Calhoun reference (Fig. 2, and col. 6, lines 1-33) disclose these limitations. Applicants respectfully disagree.

The Calhoun reference discloses:

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“The present invention then provides, in one aspect, a method of providing information on the back side of a developed photographic medium having an image carrying layer on the front side. The method comprises machine reading code on the developed imaging carrying layer on the front side of the photographic medium. In the method, information is printed on the back side of the developed photographic medium with a printer, based on the machine readable code.” (col. 2, ln. 38-46; emphasis added).

Fig. 2 illustrates sets of images 62,70 which have already been printed and developed. Thus these images (i.e. graphical representations) are not prospectively indicative of any change to the image; they are the printed photographs themselves. Bar code 80 does not provide any enhancement to the image itself such that the images may be considered only prospective. Instead the bar code 80 is indicative of information to be printed on the back side of the media. However, the final form of the image has already been printed on the front side of the media.

Therefore, for the reasons discussed herein, the applied references do not teach or suggest all of Applicants' claim limitations, and thus the rejection of claim 77 is improper at least for these additional reasons and should be withdrawn.

Claim 78 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks (“Hicks”) in view of U.S. patent 5,812,178 to Yamaguchi (“Yamaguchi”), further in view of U.S. patent 4,441,807 to Bartz (“Bartz”), further in view of U.S. patent 6,181,409 to Calhoun (“Calhoun”), and further in view of U.S. patent 5,907,391 to Kobayashi (“Kobayashi”). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on dependent claim 77, whose reasons for allowability over the Hicks, Yamaguchi, Bartz, and Calhoun references have been discussed heretofore and against which the Kobayashi reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

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Claim 83 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), further in view of U.S. patent 4,441,807 to Bartz ("Bartz"), and further in view of U.S. patent 5,805,777 to Kuchta ("Kuchta"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on claim 74, whose reasons for allowability over the Hicks, Yamaguchi, and Bartz references have been discussed heretofore and against which the Kuchta reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claim 87 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), further in view of U.S. patent 4,441,807 to Bartz ("Bartz"), and further in view of U.S. patent 5,103,406 to Hirayama ("Hirayama"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on claim 85, whose reasons for allowability over the Hicks, Yamaguchi, and Bartz references have been discussed heretofore and against which the Hirayama reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claim 88 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi

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("Yamaguchi"), further in view of U.S. patent 4,441,807 to Bartz ("Bartz"), and further in view of U.S. patent 5,583,629 to Brewington ("Brewington"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on claim 85, whose reasons for allowability over the Hicks, Yamaguchi, and Bartz references have been discussed heretofore and against which the Brewington reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claim 90 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), further in view of U.S. patent 4,441,807 to Bartz ("Bartz"), and further in view of U.S. patent 5,124,742 to Yoshikawa ("Yoshikawa"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on claim 85, whose reasons for allowability over the Hicks, Yamaguchi, and Bartz references have been discussed heretofore and against which the Yoshikawa reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Claim 92 has been rejected under 35 USC §103(a), as being unpatentable over U.S. patent 5,359,387 to Hicks ("Hicks") in view of U.S. patent 5,812,178 to Yamaguchi ("Yamaguchi"), further in view of U.S. patent 4,441,807 to Bartz ("Bartz"), and further in view of U.S. patent 3,939,784 to Meier ("Meier"). Applicants respectfully traverse the rejection and request reconsideration at least based on the dependence of this claim on claim 85, whose

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reasons for allowability over the Hicks, Yamaguchi, and Bartz references have been discussed heretofore and against which the Meier reference has not been cited. In addition, the stated motivation to combine the references is improper in that it is merely a conclusory statement of generalized advantages that impermissibly uses the Applicants' disclosure as a blueprint or in hindsight for the rejection. Therefore, the rejection is improper at least for these reasons and should be withdrawn.

Formalities

Allowable Subject Matter

Claim 71 has been objected to as being dependent upon a rejected base claim and has been indicated as being allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Applicants appreciate the indication of allowable subject matter, and respectfully request that the rewriting of these claims in independent form be deferred until a future time.

Conclusion

Attorney for Applicants has reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

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**AUTHORIZATION TO PAY AND PETITION
FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



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